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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,292	04/02/2001	Charles M. Link II	BS01-019	8769

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EXAMINER

NGUYEN, DUC M

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/822,292

Applicant(s)

LINK ET AL.

Examiner

Duc M. Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

***DETAILED ACTION***

This action is in response to the applicant's response filed on 3/29/04. Claims 1-16, 18-27 are now pending in the present application. **This action is made final.**

***Claim Objections***

Claim 20 is objected to because of the following informalities: "the" should be changed to "a" in line 5 of the claim. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted in application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-9, 13-18** are rejected under 35 U.S.C. 102(e) as being anticipated by **Hronek** (US Pat No. **6,564,055**).

Regarding claim **1**, **Hronek** discloses a method for updating the memory (internal database) of mobile phones via over-the-air programming (OTAP) using SMS messages, wherein only those mobiles in the relevant geographical region need have their IRDB updated, and wherein the update is performed upon receiving an registration

notification message from the mobile, which would include all the claimed limitations (see **entire document**), wherein update information regarding service providers or Preferred Roaming List would read on a “first information” as claimed (see col. 6, lines 33-46), only those mobiles in the relevant geographical region or having a particular subscription plan need to have their IRDB updated would read on “targeting a set of subscribers” as claimed (see col. 5, lines 1-6), the “registration notification message” would read on the “second information” as claimed (see col. 8, lines 12-38), and update information regarding system operator or service providers in SMS format would read on the “third information” as claimed (see col. 8, lines 33-38).

Regarding claims **2-9, 13**, they are rejected for the same reason as set forth in claim 1 above. In addition, Hronek further discloses

- converting first information to SMS message (see col. 8, lines 33-38) ;
- comparing second information with a record in a concerned data base (see col. 9, lines 5-64);
- a state of record (see col. 9, lines 59-64 and col. 12, lines 58-62);
- retrieve message for a wait state record (see col. 6, lines 20-63 and col. 11, lines 15-22)
- assembling third information based on characteristics of the wireless device (see col. 9, lines 36-43);
- third information is an SMS message (see col. 8, lines 33-38) ;
- create an entry in a pending database as claimed (col. 11, lines 55-57 and col. 12, lines 38-62);

Regarding claims **14-18**, the claims are interpreted and rejected for the same reason as set forth in claims 1-9 above.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **10-12, 19, 20-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Hronek**.

Regarding claim **10**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, although Hronek discloses the registration notice (second information) is sent using IS-41 signaling, it would have been obvious to one skill in the art to modify Hronek to use SS7 link in place of IS-41 as well, for utilizing advantages provided by SS7 such as flexibility and cost.

Regarding claim **11**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, when the mobile user is roaming in another network and register with the roaming network, it is clear that such registration notice would be fed to the HLR via a signal transfer point (STP) as claimed (see col. 10, lines 16-24).

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Regarding claims **12, 19**, the claims are rejected for the same reason as set forth in claim 10 above. In addition, in order to receive registration notice, it is clear that a filter would obviously be used in order to filter registration messages from raw SS7 data.

Regarding claims **20-24**, the claims are rejected for the same reason as set forth in claim 1 above. In addition, although Hronek fails to disclose the centralized database of the HLR is organized into specific databases as claimed, it would have been obvious to one skill in the art to modify Hronek to organize databases into specific databases as claimed, for easy management.

Regarding claims **25, 27**, the claims are rejected for the same reason as set forth in claims 10, 12 above.

Regarding claim **26**, the claim is rejected for the same reason as set forth in claim 11 above.

### **Conclusion**

**5. Any response to this action should be mailed to:**

Commissioner of Patent and Trademarks

Washington, D.C. 20231

or faxed to:

703-872-9314 (for formal communications intended for entry)

(for informal or draft communications, please label PROPOSED or DRAFT)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duc M. Nguyen whose telephone number is 703-306-4531. The examiner can normally be reached on Monday-Thursday (9:30 AM – 5:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on 703-305-4385. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Duc M. Nguyen



May 14, 2004